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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,239	07/02/2001	Thomas J. Kredo	7000-079	8230
27820	7590	03/24/2004	EXAMINER	
WITHROW & TERRANOVA, P.L.L.C. P.O. BOX 1287 CARY, NC 27512			CHOW, MING	
			ART UNIT	PAPER NUMBER
			2645	
DATE MAILED: 03/24/2004				

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/897,239	KREDO ET AL.
Examiner	Art Unit	
Ming Chow	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 13 January 2004.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

- 4)  Claim(s) 1-13,15-25 and 28 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-13,15-25 and 28 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .

5)  Notice of Informal Patent Application (PTO-152)

6)  Other: \_\_\_\_ .

*Claim Objections*

1. Claims 5, 8, 12, 17, 20, 24 recite "the group". There is insufficient antecedent basis for this limitation in the claim.

*Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "characteristic" claimed in claim 1 must be shown or the feature(s) canceled from the claim(s). The Fig. 2 of the specification shows the claimed "profile". However, the Fig. 2 does not include the claimed "characteristic". If Applicant refers the "characteristic" to be any one of the attributes defined in the Fig. 2 the "characteristic" must be defined accordingly. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “changing an appearance of the content” of claim 28 is not disclosed by the specification. Although, the section [0037] of specifications disclosed using capital letters, color blue and red, however, the claimed limitation “appearance” is much broader than what the specification supports. The “appearance”, in addition to what are supported by the specification, further includes other appearances like font sizes, underline, font types (times new roman, script, etc.), flashing fonts, shadow fonts, emboss fonts, engrave fonts, etc. It is old and well known to one skilled in the art that these “appearance” functions require different software or hardware or

both to support. For example, when a user uses a mono color (black-and-white) monitor for receiving the instant message, the Applicant's claimed limitation will fail because no colors will be shown or changed on the monitor. Also, different font display requires that particular font software to support. Without the proper font software installed, the Applicant's claimed limitation will fail to change the appearance. Applicant's claim has claimed limitations that are beyond the support of its specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 13, 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "acts" is not clearly defined. It is unclear the "acts" is performed by the limitation "providing", or "a profile", or "at least one characteristic".

5. Claims 1, 13, 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "one characteristic" (line 7) and "message characteristic" (line 9-10) are not clearly defined. It is unclear the "one characteristic" refers to "characteristic of providing" or "profile characteristic". It is unclear if the "one characteristic" (line 7) and "message characteristic" (line 9-10) refer to the same limitation.

6. Claims 3, 4, 7, 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “the creating step” is not clearly defined. It is unclear the “creating step” refers to “creating a call dialog” or “creating an instant message” in claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 2, 4-11, 13, 16-23, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dowens et al (US: 6389114), and in view of Taylor (US: 6424935).

Regarding claims 1, 13, 25, Dowens et al teach on Abstract – provides a telecommunication relay device that relays communication from a first party to at least one second party (reads on claimed “creating a call dialog”).

Dowens et al teach on column 1 line 24-35, converting telephone user’s voice (claimed “audio command”) to text (claimed “message meaning”) for chat room (claimed “instant messaging” and “sending the....messaging service”). The audio command is received during the

communication relays (claimed “call dialog”). Therefore, the command is received according to the call dialog.

Dowens et al failed to teach “providing a profile.....a second user”. However, Taylor teaches on column 3 line 13-24 a speech-to-text system with a dialect database (claimed “profile including at least one characteristic”) for determining the dialectal characteristic. Taylor teaches on column 9 line 55-58 identify the transcribed text corresponding to each speaker by highlighting the different speaker’s text in different colors or fonts on the user interface (reads on claimed “affects how message meaning is presented” and “appearance and content is affected at least in part by the message characteristic”)

It would have been obvious to one skilled at the time the invention was made to modify Dowens et al to have “providing a profile.....a second user” as taught by Taylor such that the modified system of Dowens et al would be able to support the profile including characteristic that affects presenting appearance of the message meaning to the system users.

Regarding claim 2, the modified system of Dowens et al in view of Taylor as stated in claim 1 above failed to teach “providing a profile.....said personality”. However, Taylor teaches on column 3 line 39-50 the characteristic includes claimed “personality” like “type of work that they do” (see “business” on Fig. 2 of specification), “where they grew up” (see “west coast” “east coast” on Fig. 2 of specification), speaker’s age (see “child” on Fig. 2 of specification).

It would have been obvious to one skilled at the time the invention was made to modify Dowens et al, Taylor to have as “providing a profile.....said personality” taught by Taylor such

that the modified system of Dowens et al, Taylor would be able to support the profile defines a personality to the system users.

Regarding claims 4, 5, 16, 17, Dowens et al teach on column 3 line 50 smile emoticons. The smile emoticons are the claimed “emotional indicia” and reads on the claimed “characteristic relates to emotion”.

Regarding claims 6 and 18, the modified system of Dowens in view of Taylor as stated in claim 2 above failed to teach “when the message.....said personality”. However, Taylor teaches on column 6 line 26-30 the lexicon (claimed “text”) can be selected for particular dialects (reads on claimed “according to said personality”).

It would have been obvious to one skilled at the time the invention was made to modify Dowens et al, Taylor to have “when the message.....said personality” as taught by Taylor such that the modified system of Dowens et al, Taylor would be able to support the message meaning presented according to said personality to the system users.

Regarding claims 7 and 19, Dowens et al teach on column 3 line 37-43 message characteristic relates to a relative volume.

Regarding claims 8 and 20, the rejections of claims 4-7 regarding message characteristics relate to volume, personality, and emotion as stated above apply.

Regarding claims 9 and 21, Dowens et al teach on column 3 line 37-43 regarding boldface, italics or underlined text for indicating characteristic. It is obvious that when plain text (default text font and size) is used it shows the claimed predefined characteristic.

Regarding claims 10, 11, 22 and 23, Dowens et al teach on column 3 line 60 to column 4 line 5 regarding text-to-audio (receiving an instant message, converting the instant message to an audio message, and sending the audio message to the telephony user).

Regarding claim 28, Dowens et al teach on column 3 line 37-59 audio-to-text transcoding (converting an audio command into an instant message). When the instant message is created the appearance of content is changed from audio form to text form.

8. Claims 3, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dowens et al, and in view of Taylor, Horvitz et al (US: 5864848).

Dowens et al in view of Taylor failed to teach “the profile.....message characteristic”, However, Horvitz et al teach on Abstract, extracting data from one or more source objects (claimed “audio command”) and applying the data to one or more target objects (the claimed “instant message”) by using one or more templates (the claimed “profile”; column 4 line 26-46). The template includes source objects of user gesture (the claimed “characteristics”; column 4 line 7-13) and message meaning (column 12 line 8-13). Horvitz et al teach on column 11 line 2-5, the “relevant terms” of Horvitz et al is the claimed “unique text”.

It would have been obvious to one skilled at the time the invention was made to modify Dowens et al and Taylor to have “the profile includes....possible message characteristics” as taught by Horvitz et al such that the modified system of Dowens et al and Taylor would be able to support the unique text to the system users.

9. Claims 12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dowens et al, and in view of Taylor, Hodges et al (US: 6449365). Dowens et al and Taylor failed to teach “sending an alert....sending a page”. However, Hodges et al teach on column 9 line 42 the notification server may transmit a notification message .... using a conventional short message service (SMS). Hodges et al also teach on column 9 line 46 the notification server may also transmit a notification message to the recipient’s conventional telephone. The “notification message” of Hodges et al is the claimed “alert”. The “conventional telephone” of Hodges et al reads on the claimed “calling”. It would have been obvious to one skilled at the time the invention was made to modify Dowens et al and Taylor to have “sending an alert....sending a page” as taught by Hodges et al such that the modified system of Dowens et al and Taylor would be able to support the alert to the system users.

*Response to Arguments*

10. Applicant's arguments filed on 1/13/04 have been fully considered but they are not persuasive.

- i) Applicant argues, on page 8, regarding claim 28. See 35 USC 112 rejections as stated above.
- ii) Applicant argues, on page 10, regarding the recited prior art (Horvitz et al). First, Applicant's specification states, on section [0031], profile server can be accessed by a personal computer or like computing device. The profile must be accessed by a computer. Horvitz et al teach a profile including characteristics on a computer environment. The referencing of Horvitz et al is to teach a profile including characteristics on a computer environment. As Dowens et al in view of Taylor teaches a profile on a computer environment for creating instant messages. It is a perfect motivation to combine Dowens et al, Taylor, and Horvitz et al so that the profile including the characteristics on the computer environment can be used for creating instant messages.

*Conclusion*

11. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- Dutta et al (US: 6453294) teach dynamic destination-determined multimedia avatars for interactive on-line communications.

12. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

**Or faxed to Central FAX Number 703-872-9306.**

Patent Examiner

Art Unit 2645

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(M)

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